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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,471	09/21/2001	Kimihiko Nishioka	P 283651 OL97501N-US	4064
909	7590	02/07/2006	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			LESTER, EVELYN A	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2873	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/957,471	Applicant(s) NISHIOKA ET AL.	
	Examiner Evelyn A. Lester	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 7-18, 20 and 27-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 21-26 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-07-05 has been entered.

Status of Claims

2. Claims 1-18 and 20-38 are pending. Claims 19 and 39 have been cancelled. Of the pending claims, claims 1-4, 7-20 and 27-37 are withdrawn as being directed to a non-elected species (please note office action mailed on 7-7-05, pages 2-3). Claims 5, 6, 21-26 and 38 are herein examined on the merits.

The Applicants should note that claims 18 and 20 are labeled as "(Original)," however, these claims are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, 21-26 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 6, 21-26 and 38 recite the limitation "said variable-optical-characteristic optical element," as recited in claim 5, at lines 3-4 and line 7; in claim 6, line 3; in claim 21, line 3. There is insufficient antecedent basis for this limitation in the claim. This indefiniteness resulted from the amendments made to the preamble of the claims. With respect to claims 22-26 and 38, these claims incorporate the indefiniteness from the claims they depend from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 5 and 6, as far as these claims are understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hochstrate (U.S. Patent 4,238,793).

Hochstrate discloses the claimed invention of a variable optical element (10) comprising a power source (23) and a drive circuit (including “booster member” 32; 25,27,9, for example), wherein piezoelectric effect is used (note col. 6, lines 1-6). Please note Figure 6, and its accompanying text, for example.

With respect to the preamble of the claims, wherein the phrase “variable focus” is stated, the Applicants should note that a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure of the claimed invention. Consequently, the preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant. The above indicated phrase in the preamble reciting the purpose or intended use of the claimed invention has been evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. In the instant case, it has been determined by the Examiner that the recitation does not serve to limit the claim. [See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (*The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.*); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (*statement of intended use in an apparatus claim did not distinguish over the prior art apparatus*).] See also MPEP § 2114.

5. Claims 21-26 and 38-39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schachar (U.S. Patent 5,774,274).

Schachar discloses the claimed invention of a variable "focus" optical element having a deformable optical surface (Figure 9, element 402 (i.e. lens), which has two surfaces which are deformable, col. 9, lines 1-25), and the claimed invention further comprises a control system (equatorial ring of piezoelectric material with electric voltage applied) for driving the variable "focus" optical element. The control system includes a "booster member" in element 406, i.e. solenoids, for applying a voltage necessary for driving. It is through and because of the solenoids that the voltage is applied in order for the driving of the control system. The lens is a vari-focal lens element using a fluid. Please note for example Figure 9, and its accompanying text.

With respect to claims 24-26 and 38-39, these claims contain recitation with respect to the manner in which the claimed inventions are intended to be employed. This does not differentiate the claimed invention from the prior art apparatus, when the prior art invention teaches all the structural limitations of the claim. (MPEP 2114). In the instant case, the variable focus optical element is used for imaging optical systems.

Response to Arguments

6. Applicant's arguments filed 11-7-05 have been fully considered but they are not persuasive.

With respect to claims 15 and 19, previous arguments presented were "reiterated," however, claims 15 and 19 are withdrawn as being directed to a non-elected species. Therefore, they are not examined, so they will not be allowed.

With respect to the Applicants "reiteration" of their arguments regarding the election of species requirement, this has been made final and will not be withdrawn, for reasons already stated in a previous office action.

In response to Applicant's argument that Hochstrate (U.S. Patent 4,238,793) is directed to an optical system having an electroluminescent panel and is not a "variable-focus optical element," the Applicant's are reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Please note the above explanation included with the prior art rejection, paragraph 4. Hochstrate discloses all of the claimed structural elements of the claimed invention, therefore the prior art rejection is maintained.

In response to the Applicant's argument that Schachar (U.S. Patent 5,774,274) has solenoids which do not apply a voltage for driving the deformable lens, but is instead driven by an electromagnetic force, therefore does not correspond to the booster member of claim 21. The Examiner disagrees with this argument, because the solenoid, though it drives with an electromagnetic force, it is the application of voltage to the wire elements of the solenoid, which creates the electromagnetic force, which in turn drives the deformable lens. Therefore the solenoid does read on the "booster member" recited in claim 21, and the prior art rejection is hereby maintained.


The Applicant's arguments presented with respect to the prior art rejections addressed the independent claims, with the dependent claims following their respective independent claim. Therefore, no additional arguments are addressed here with respect to the dependent claims, claims 6, 22-26 and 38. The Applicant is respectfully reminded that claim 39 has been cancelled.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on subject to an increased flex schedule, M-F, 10-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Evelyn A. Lester
Primary Examiner
Art Unit 2873